



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,538	06/19/2001	Adi Harari	45485/DMC/1275	6454

23363 7590 07/07/2005
CHRISTIE, PARKER & HALE, LLP
PO BOX 7068
PASADENA, CA 91109-7068

EXAMINER

DUONG, THOMAS

ART UNIT PAPER NUMBER

2145

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/886,538

Applicant(s)

HARARI, ADI

Examiner

Thomas Duong

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

no

DETAILED ACTION

Response to Amendment

1. This office action is in response to the applicants Amendment filed on April 18, 2005.
Applicant canceled *claims 1-2* and added *claims 3-16*. *Claims 3-16* are presented for further consideration and examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. *Claims 3-12 and 16* are rejected under 35 U.S.C. 103(a) as being unpatentable over Celik (US006374259B1), in view of Delany et al. (US006658454B1), and further in view of Cotten (US006330590B1).
4. With regard to *claims 3 and 15*, Celik discloses,
 - *receiving, over the Internet, contact information regarding a user;* (Celik, col.1, lines 50-58; col.2, lines 8-26; col.4, lines 8-22)

Celik teaches of *"an information management method [that] includes step of ... storing information coupled to a remote computer"* (Celik, col.1, lines 51-55) by allowing *"a user (hereinafter User 1) of the first personal computer 12 to [access] the remote computer over the internet to input business contact information of*

Art Unit: 2145

User 1 or other information that User 1 wishes to store in the database 18" (Celik, col.4, lines 12-16).

- *storing in a computer accessible memory the contact information regarding the user;* (Celik, col.1, lines 50-58; col.2, lines 8-26; col.4, lines 8-22)

Celik teaches of *"an information management method [that] includes step of ... storing information coupled to a remote computer"* (Celik, col.1, lines 51-55) by allowing *"a user (hereinafter User 1) of the first personal computer 12 to [access] the remote computer over the internet to input business contact information of User 1 or other information that User 1 wishes to store in the database 18"* (Celik, col.4, lines 12-16).

- *receiving, over the Internet, information regarding contacts of the user;* (Celik, col.1, lines 50-58; col.2, lines 8-26; col.4, lines 8-22)

Celik teaches of *"an information management method [that] includes step of ... storing information coupled to a remote computer"* (Celik, col.1, lines 51-55) by allowing *"a user (hereinafter User 1) of the first personal computer 12 to [access] the remote computer over the internet to input business contact information of User 1 or other information that User 1 wishes to store in the database 18"* (Celik, col.4, lines 12-16). Hence, Celik implies of a user inputting business contact information or other information such as contact information of business acquaintances, family members, friends, etc. into the database on the remote computer.

However, Celik does not explicitly disclose,

- *forming a distribution list contacts of the user using the information regarding contacts the user; and*

Delany teaches,

- *forming a distribution list contacts of the user using the information regarding contacts the user; and* (Delany, col.4, line 22 – col.5, line 45)

Delany teaches of *“a distribution or ‘mailing list’ [that] is employed to facilitate the process of sending an e-mail message to a group of people”* (Delany, col.4, lines 27-28) when sending e-mail; wherein the *“mailing list can be used in the recipient field for an e-mail message, in lieu of listing individual members, so that a message sent to this distribution list goes to all recipients listed”* (Delany, col.4, lines 41-44).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Delany with the teachings of Celik to provide an information management method wherein *“instead of addressing an e-mail message to individual members of a recurring group, a user can instead simply define a mailing list to comprise those members”* (Delany, col.4, lines 29-31) wherein *“a distribution or ‘mailing list’ is employed to facilitate the process of sending an e-mail message to a group of people”* (Delany, col.2, line 66 – col.3, line 1).

However, Celik and Delany do not explicitly disclose,

- *providing the contact information to at least some of the contacts of the user on the distribution list.*

Cotten teaches,

- *providing the contact information to at least some of the contacts of the user on the distribution list.* (Cotten, col.1, lines 11-23)

Cotten teaches that *“bulk e-mail companies thus tend to build and release mailing lists of e-mail addresses and use those lists to send messages with little*

discrimination or protection of the recipient's rights, desires or needs" (Cotten, col.1, lines 20-23). Hence, Cotten implies that it is known in the art that certain companies collect and distribute or release users' personal information to another party such as a marketing company or another user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Cotten with the teachings of Celik and Delany to provide an information management method wherein collected users' personal information are distributed or released to another party, whereby *"instead of addressing an e-mail message to individual members of a recurring group, a user can instead simply define a mailing list to comprise those members"* (Delany, col.4, lines 29-31), wherein *"a distribution or 'mailing list' is employed to facilitate the process of sending an e-mail message to a group of people"* (Delany, col.2, line 66 – col.3, line 1).

5. With regard to claims 4-5 and 16, Celik, Delany, and Cotten disclose,

- *wherein providing the contact information to at least some of the contacts of the user on the distribution list comprises sending an e-mail to at least some of the contacts of the user on the distribution list.* (Delany, col.4, line 22 – col.5, line 45; Cotten, col.1, lines 11-23)
- *wherein the at least some of the contacts of the user on the distribution list are those contacts of the user on the distribution list having an e-mail address.* (Delany, col.4, line 22 – col.5, line 45; Cotten, col.1, lines 11-23)

6. With regard to claims 6-8, Celik, Delany, and Cotten disclose,

- *wherein receiving contact information regarding the user comprises receiving by a server contact information regarding the user from a client.* (Delany, col.4, line 22 – col.5, line 45; Cotten, col.1, lines 11-23)
 - *wherein the server sends the e-mails to at least some the contacts of the user the distribution list.* (Delany, col.4, line 22 – col.5, line 45; Cotten, col.1, lines 11-23)
 - *wherein the user is a registered user and e-mails are sent to contacts of the user who are not registered users.* (Celik, col.1, lines 50-58; col.2, lines 8-26; col.4, lines 8-22; Delany, col.4, line 22 – col.5, line 45; Cotten, col.1, lines 11-23)
7. With regard to claims 9-12, Celik, Delany, and Cotten disclose,
- *wherein the contact information regarding the user comprises updated contact information regarding the user.* (Delany, col.4, line 22 – col.5, line 45; Cotten, col.1, lines 11-23)
 - *wherein the server sends the e-mails to at least some of the contacts of the user in the distribution list.* (Delany, col.4, line 22 – col.5, line 45; Cotten, col.1, lines 11-23)
 - *wherein the server sends the e-mails to at least some of the contacts of the user on the distribution list automatically in response to receiving updated contact information regarding the user.* (Delany, col.4, line 22 – col.5, line 45; Cotten, col.1, lines 11-23)
 - *further comprising data stamping the contact information of the user.* (Delany, col.4, line 22 – col.5, line 45; Cotten, col.1, lines 11-23)

Art Unit: 2145

8. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Celik (US006374259B1), in view of Delany et al. (US006658454B1), in view of Cotten (US006330590B1), and further in view of Fisher et al. (US006047264A)

9. With regard to claims 13-14, Celik, Delany, and Cotten disclose,

See *claim 3* rejection as detailed above.

However, Celik, Delany, and Cotten do not explicitly disclose,

- *further comprising maintaining at least one flag indicating whether a contact of the user should receive automatic updates of contact information of the user.*
- *further comprising maintaining at least one flag indicating whether the user should receive automatic updates of contact information of a contact of the user.*

Fisher teaches,

- *further comprising maintaining at least one flag indicating whether a contact of the user should receive automatic updates of contact information of the user.*

(Fisher, col.1, line 56 – col.2, line 40; col.3, line 59 – col.4, line 27)

Fisher teaches of a “*status receiver 14 [that] signals electronic mail messenger 15, via an ‘Updated Status’ flag in the appropriate database records, that a new update message should be sent*” (Fisher, col.4, lines 4-8). Hence, Fisher teaches the use of a flag to indicate that a particular record should receive automatic updates upon their availability.

- *further comprising maintaining at least one flag indicating whether the user should receive automatic updates of contact information of a contact of the user.*

(Fisher, col.1, line 56 – col.2, line 40; col.3, line 59 – col.4, line 27)

Art Unit: 2145

Fisher teaches of a *"status receiver 14 [that] signals electronic mail messenger 15, via an 'Updated Status' flag in the appropriate database records, that a new update message should be sent"* (Fisher, col.4, lines 4-8). Hence, Fisher teaches the use of a flag to indicate that a particular record should receive automatic updates upon their availability.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Fisher with the teachings of Celik, Delany, and Cotten to provide an information management method wherein *"instead of addressing an e-mail message to individual members of a recurring group, a user can instead simply define a mailing list to comprise those members"* (Delany, col.4, lines 29-31) wherein *"a distribution or 'mailing list' is employed to facilitate the process of sending an e-mail message to a group of people"* (Delany, col.2, line 66 – col.3, line 1).

Response to Arguments

10. Applicant's arguments with respect to *claims 3-16* have been considered but they are moot in view of the new grounds of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE

Art Unit: 2145

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Duong whose telephone number is 571/272-3911. The examiner can normally be reached on M-F 7:30AM - 4:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 571/272-6159. The fax phone numbers for the organization where this application or proceeding is assigned are 703/872-9306 for regular communications and 703/872-9306 for After Final communications.

Thomas Duong (AU2145)

June 21, 2005


VALENCIA MARTIN-WALLACE
SUPERVISORY PATENT EXAMINER